

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO LORENZI

Appeal No. 2006-1384
Application No. 10/408,809
Technology Center 3700

Before ANITA PELLMAN GROSS, JENNIFER D. BAHR, and ANTON W. FETTING,
Administrative Patent Judges.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

Mario Lorenzi (appellant) appeals under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4-7 and 14. Claims 2 and 3 have been canceled, claims 8-11 stand objected to as depending from a rejected claim and claims 12 and 13 stand allowed.

We REVERSE.

THE INVENTION

The appellant's invention relates to a device for moving books in or in connection with an adhesive or perfect binding device (present specification, p. 1). The device includes a vertical transport device comprising two conveyor chains O for driving a plurality of movable containers V connected to the chains. The moveable containers V are generally L-shaped and include a support plane V_p and a stop edge V_b, as illustrated in Fig. 2. Electrically driven fans E disposed between the chains direct airflow toward the stop edge V_b of the containers V and toward the book spines (specification, p. 14).

THE REPRESENTATIVE CLAIM

Claim 1, the only independent claim before us on appeal, reads as follows:

1. A device for moving books, comprising:
 - a transport device vertically transporting the books;
 - a plurality of movable platforms connected to said transport device and having a vertical conveying path;
 - a fixedly disposed platform located adjacent said vertical conveying path;
 - an unloading device for transferring books, previously loaded on said movable platforms, to said fixedly disposed platform from said movable platforms; and
 - at least one cooling device disposed along said vertical conveying path for at least partly cooling the books.

THE EVIDENCE

The examiner relies upon the following as evidence of unpatentability:

Milhaupt	3,235,101	Feb. 15, 1966
Gram	4,284,188	Aug. 18, 1981
Rathert	5,375,967	Dec. 27, 1994

THE REJECTIONS

The appellant seeks review of the examiner's rejections of claims 1, 4, 7 and 14 under 35 U.S.C. § 102(b) as being anticipated by Gram, claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Gram in view of Rathert and claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Gram in view of Milhaupt.

The examiner presents reasoning in support of the rejections in the examiner's answer (mailed July 25, 2005). The appellant offers opposing arguments in the appellant's brief (filed June 15, 2005).

OPINION

The appellant and the examiner disagree about the weight that should be given to the books, the material worked on in the claimed device. *See* brief, pp. 6-7 and answer, p. 4. Accordingly, the first issue in this appeal is one of claim interpretation and, in particular, the weight to be given to the term "books" in claim 1.

We thus begin our review of the rejections involved in this appeal by first interpreting the language of independent claim 1. In so doing, we keep in mind the following principle:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). If the claim preamble, when read in the

context of the entire claim, recites limitations of the claim, or, if the claim preamble is “necessary to give life, meaning, and vitality” to the claim, then the claim preamble should be construed as if in the balance of the claim.

Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed Cir. 1999).

The preamble of appellant’s claim 1 recites a “device for moving books” and the balance of the claim recites, *inter alia*, “a transport device vertically transporting the books.” The active limitation “vertically transporting the books” does not make sense without a positive recitation of books. Thus, in this case, the preamble must be read as positively reciting books, as well as the device for moving them, and, because this recitation is necessary to give life, meaning and vitality to the limitation “a transport device vertically transporting the books,” must further be construed as if in the balance of the claim. In other words, claim 1, when read as a whole, includes a positive recitation of books vertically transported on the transport device.

Having determined that claim 1 positively recites books vertically transported on the transport device, we now turn to the second issue. The second issue in this appeal is whether Gram teaches or suggests books vertically transported on a transport device.

Gram, while arguably *capable* of vertically transporting books, albeit perhaps preferably not books that have been freshly bound using adhesive, on carriers 3, does not in fact disclose books being transported on the carriers. Gram indicates that the disclosed apparatus is “for processing articles, e.g. for cooling or freezing such articles or goods” (col. 1, ll. 8-10) and refers to US. Pat. No. 3,993,189 (issued to Khoylian et al. on November 23, 1976) for an example of an apparatus of this kind (col. 1, ll. 20-21). The Khoylian patent describes the processing conveyor disclosed therein as related to “automatic processing, such as food processing, and particularly to a novel conveying

system for moving food products or other articles through a processing cycle” (col. 1, ll. 3-6) and mentions facilitating the continuous movement of “products such as fish sticks, vegetables, fried potatoes, pies or the like, in unpackaged form or in pans, packages, or the like” (col. 1, ll. 49-52). Against this background, one of ordinary skill in the art would not have construed Gram’s apparatus as handling books, a required element of claim 1.

Accordingly, Gram does not anticipate claim 1. The anticipation rejection of claim 1, and claims 4, 7 and 14 depending from claim 1, therefore cannot be sustained.

Moreover, given the background of the invention as set forth in Gram and in the Khoyleian patent referenced in Gram, discussed above, one skilled in the art would have found no suggestion in Gram, or in the additional teachings of Rathert and Milhaupt relied on by the examiner in rejecting dependent claims 5 and 6, to transport books on the Gram apparatus. It thus follows that we also cannot sustain the rejections of claim 5 as being unpatentable over Gram in view of Rathert and claim 6 as being unpatentable over Gram in view of Milhaupt.

SUMMARY

To summarize, the decision of the examiner to reject claims 1, 4, 7 and 14 under 35 U.S.C. § 102(b) and claims 5 and 6 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED

ANITA PELLMAN GROSS)
Administrative Patent Judge)
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) BOARD OF PATENT
JENNIFER D. BAHR) APPEALS
Administrative Patent Judge) AND
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